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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,002	10/30/2003	Shinobu Sakurada	1300-000008	7421

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EXAMINER

DIXON, MERRICK L

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,002

Applicant(s)

SAKURADA ET AL.

Examiner

Merrick Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-914)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

MERRICK DIXON

PRIMARY EXAMINER

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1. The abstract of the disclosure is objected to because it contains the legal word, "comprising". Correction is required. See MPEP § 608.01(b).

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The disclosure is objected to because of the following informalities: No English translation therefor was submitted.

Appropriate correction is required.

4. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner is unable to determine if support for the claims exist in the specification as same specification was not submitted in English language..

5. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner is unable to determine if support for the claims, as presented, exist in the specification as same specification was not submitted in English language.

6.

It is noted the hereinafter rejection is offered as best understood by the examiner and presented by the submitted claims. It is noted the submitted specification's lack of translation (to English), presents difficulties as to the complete metes of the claimed invention.

Claim 2 is a product by process claim and treated as such herein.

Product by process claims are based on product itself eventhough such claims recite process steps and thus the products in such claims are unpatentable if they are the same as, or, obvious from, the product of the prior art, even if the prior product was made by different processes. *In re Thorpe et al*, 227 USPQ 964(1985); *In re Marosi* 218 USPQ 964(1985). See MPEP 706.03(e).

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A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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Claims 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 2 of copending Application No. 10/787895. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Any additional rings are inherent for the material are identical.

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Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 3 are of copending Application No. 10/508479. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

All additional rings are inherent for the material are identical

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by JP-2001-75,297.

The reference teaches a liquid crystal compound having charge transfer property and ferroelectricity. The reference 's crystal compound has $>1 \times 10 \exp -5 \text{ cm exp } 2/V.\text{sec}$ positive hole mobility. The reference further teaches that the liquid crystal has 6 pi

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electron-based aromatic group, L, 10 pi electron based aromatic group, M, and/or 14 pi electron base aromatic group, N, cores. Where $L+M+N=1$ to 4. Each of L, M and M is integers)-4. Further, the liquid crystal compound has 2-phenyl naphthalene ring . In section [0011] of the reference, the core includes phenylnaphthallene , biphenyl, benzothiazole and t-thiophene with side chain of alkyl or alkoxy group as required by claim 3.

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Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2001-33,990. The reference teaches a photoconductive layer composed of an organic semiconductor liquid crystalline and dielectric layer on electrodes . the reference 's liquid crystal compound has $>1 \times 10^{-5} \text{ cm}^2/\text{V} \cdot \text{sec}$ electron mobility and $> 1 \times 10^{-5} \text{ cm}^2/\text{V} \cdot \text{sec}$ positive hole mobility. The reference teaches liquid crystal compound , with 6 pi electron based aromatic group, L. M, 10 pi electron based aromatic group. N, 14 pi electron based aromatic group. $L+M+N=1-4$. Such inclusions would cause the material to behave in similar manner as claimed and required by claims 2 and 3. See section [0010] of the reference. Also, see sections [0016-0017].

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Applicants who wish to send a facsimile (draft copies) for the examiner's immediate review can do so by using the Examiner's personal fax number at 571-273-1520. The faxing of all papers must conform with the notice published in the Official Gazette, 1096

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O.G. 30 (November 15, 1989). **NOTE: All facsimiles sent to the examiner's personal fax number should be in draft-forms and will be treated as informal.**

Same facsimiles will not be entered in the related applications unless otherwise agreed and noted by the examiner.

The fax number for all other fascimile is 703-872-9306.

Information about **the status of an application** may be obtained from the Patent Information Retrieval system (**Private PAIR**).

Status inquires for **published applications** may be retrieved from either **Private PAIR** or **Public PAIR**. Questions about the PAIR system should be directed to the Electronic Business Center at **866-217-9197**.

Any questions concerning the instant communication should be directed to Examiner Dixon, at 571-272-1520, Mondays to Thursdays, between 12 noon and 8 PM, eastern time . The examiner's supervisor, Mrs. Rena Dye, can be reached at 571-272-3186.

A handwritten signature in black ink, appearing to read 'Merrick Dixon', with a long horizontal flourish extending to the right.

Merrick Dixon

Primary Examiner

Group 1700